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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/380,888	10/27/1999	CHRISTINE DUPUIS	05725.0473	3192

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EXAMINER
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WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 09/12/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/380,888

Applicant(s)

DUPUIS, CHRISTINE

Examin r

Lauren Q Wells

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 18-21,24-34 and 36-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-21,24-34 and 36-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1617

### **DETAILED ACTION**

Claims 18-21, 24-34, 36-53 are pending. The amendment filed 5/27/03, Paper No. 26, cancelled claim 35 and amended claims 18, 24, 26 and 28.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/25/03 has been entered.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 18-21, 24-34, 36-39, 51-52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 and 24 of U.S. Patent No. 6,338,858. Although the conflicting claims are not identical, they are not patentably distinct from each other. The instant application recites a composition comprising an aqueous gel which comprises a hydrophilic gelling material, wherein the gel has rheological properties of an initial

Art Unit: 1617

viscosity of 3000-50,000 Pa.s, wherein said initial viscosity is stable up to a shear strain C1, a viscosity V2 after shear at a strain of C2, wherein the ratio of the initial viscosity to V2 is greater than or equal to 1000, and a difference of C2-C2 is less than or equal to 100 PA, wherein said hydrophilic gelling material is a compound of formula (I) with a MW is at less than 20,000, and which comprises 0.5-15% of the composition.

'858 teaches a composition comprising an aqueous gel which comprises a hydrophilic gelling material, wherein the gel has rheological properties of an initial viscosity of 3000-50,000 Pa.s, wherein said initial viscosity is stable up to a shear strain C1, a viscosity V2 after shear at a strain of C2, wherein the ratio of the initial viscosity to V2 is greater than or equal to 1000, and a difference of C2-C2 is less than or equal to 100 PA, wherein said hydrophilic gelling material is a compound of formula (I) with a MW is less than 20,000.

The only difference between the instant independent claim and that of '858 is that '858 does not teach the percent weight of the hydrophilic gelling material in the composition. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the gelling agent of '858 as comprising 0.5-15% of the composition because a) it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (In re Aller, 105 USPQ 233) and b) because the instant invention and '858 teach their gelling agents as forming gel compositions for cosmetic use; thus, one of skill would be motivated to teach the amount of the agents of '858 as the same as that of the instant invention because of the expectation of achieving a cosmetically acceptable formulation for application to the skin and/or hair.

Art Unit: 1617

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-21, 24-34, 36, 39, 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neill et al. (4,300,580).

The instant invention is directed toward a composition comprising an aqueous gel which comprises a hydrophilic gelling material, wherein the gel has rheological properties of an initial viscosity of 3000-50,000 Pa.s, wherein said initial viscosity is stable up to a shear strain C1, a viscosity V2 after shear at a strain of C2, wherein the ratio of the initial viscosity to V2 is greater than or equal to 1000, and a difference of C2-C2 is less than or equal to 100 PA, wherein said hydrophilic gelling material is a compound of formula (I) with a MW is less than 20,000, and which comprises 0.5-15% of the composition.

O'Neill et al. teach hair grooming methods using compositions comprising linear polyesters of formula (I) of the instant invention, wherein n is 2-10. Linear polyesters are derived from at least one dicarboxylic acid, at least one diol, and a difunctional monomer containing a -SO<sub>3</sub>M group attached to an aromatic nucleus. The difunctional monomer containing the -SO<sub>3</sub>M groups comprises at least 8 mole percent of the polyester, and the diol comprises at least 8 mole percent. Thus, the dicarboxylic acid can comprise up to 84 mole percent of the polyester. Exemplified is a polymer made by mixing dimethyl isophthalate (1,3

Art Unit: 1617

phenylene group), dimethyl terephthalate (1,4 phenylene group), dimethyl 5-sodiuousulfoisophthalate (sulfo-1,3-phenylene group), and diethylene glycol, wherein the polymers are taught as comprising 5% of the composition as a whole. The composition is applied as a spray to the hair. Dyes, pigments, stabilizers, and plasticizers are taught as additives. A method of applying the composition to the hair is taught. The reference lacks preferred percent weights of the monomer units and explicitly teaches of molecular weight and rheological properties. See Col. 1, line 41-Col. 5, line 5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the mole percents of the monomers of O'Neill et al. as those of the instant invention, since a) O'Neill et al. generally teaches the mole percents of the monomers, and b) it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

The Examiner respectfully points out that a compound and its properties are inseparable. In re Papesch 315 F.2d 381, 391, 137 USPQ 43, 51 (CCPA 1963). See MPEP 2141.02. Thus, since the instant invention and O'Neill teach the same compounds for formula (I), with the same "n" values, the molecular weight must be the same. Moreover, regarding the viscosity and shear strain recitations, it is pointed out that on pages 4-5, of the instant specification, it is recited that "the hydrophilic gelling material according to the invention consists of any gelling material which can form a gel or a composition having the appearance of a gel and having the rheological profile according to the invention. According to one preferred embodiment of the invention, the hydrophilic gelling material is a hydrophilic gelling polymer. . . Such polymers can be, more

Art Unit: 1617

particularly, water-soluble or water-dispersible terephthalic copolyester oligomers essentially comprising dicarboxylate repeating units of formula (I). . . (I')". Thus, since O'Neill teaches the same compounds of formula (I), as those of the instant invention, the rheological properties must be the same, though they are not explicitly stated by O'Neill.

Claims 37-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neill et al. as applied to claims 18-21, 24-34, 36, 39, 51-53 above, and further in view of Lee et al. (EP 0551748).

O'Neill et al. is applied as discussed above. The reference lacks a fatty phase and a device.

Lee et al. teach hair treatment compositions comprising a water-insoluble, dispersible polymeric resin in water. Diglycol/cyclohexanedimethanol/isophthalates/sulphoisophthalates polyester taught as a resin. Hairsprays in aerosol and nonaerosols are taught. Specifically taught as nonaerosol hairsprays are devices with pump spray containers, wherein such devices have valve systems controlled by distribution heads. It is respectfully pointed out that hairsprays must be in devices that vaporize the composition in order for them to function as sprays. Dimethyl ether, propane, butane, and isobutene are taught as propellants for aerosols. The propellants comprise 3-50% of the composition. C10-C20 fatty alcohol esters are disclosed as additives that counteract the dullness effect of the polymeric resins. See pg. 3, lines 12-pg. 4, line 14.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the C10-C20 fatty alcohols of Lee et al. in the composition of O'Neill et al. because a) O'Neill and Lee are both directed to hair care compositions comprising

Application/Control Number: 09/380,888

Art Unit: 1617

sulfopolyesters in the form of sprays; b) Lee teaches that adding fatty alcohols to compositions comprising sulfopolyesters counteracts the dullness imparted to the hair by the polyesters.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the composition of O'Neill et al. in the device of Lee et al. because O'Neill teaches his compositions in the form of a spray for application to the hair and Lee et al. teach their devices as cosmetically acceptable for applying a spray to the hair; thus, one of skill in the hairspray art would be motivated to teach the device of Lee et al. as the spray device of O'Neill et al.

#### *Response to Arguments*

Applicant argues, "O'Neill further disclosed that many different acids, diols, and monomers containing a  $-SO_3M$  group attached to an aromatic nucleus may be used in formulating polyesters, but does not disclose rheological properties for these possible combinations. . .there is not direct teaching or even a suggestion in O'Neill that indicates the viscosities, with the shear strains, recited in the claimed invention. Furthermore, O'Neill is completely silent with regard to disclosing a molecular weight for any of the possible combinations". This argument is not persuasive. First, the Examiner respectfully points out that it is well established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. In re Boe, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); In re Kaslow, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983).



Application/Control Number: 09/380,888  
Art Unit: 1617

Second, the Examiner respectfully points out that Example 1 of O'Neill specifically teaches a compound of formula (I), as instantly claimed.

Third, the Examiner respectfully points out that a compound and its properties are inseparable. In re Papesch 315 F.2d 381, 391, 137 USPQ 43, 51 (CCPA 1963). See MPEP 2141.02. Thus, since the instant invention and O'Neill teach the same compounds for formula (I), with the same "n" values, the molecular weight must be the same. Moreover, regarding the viscosity and shear strain recitations, it is pointed out that on pages 4-5, of the instant specification, it is recited that "the hydrophilic gelling material according to the invention consists of any gelling material which can form a gel or a composition having the appearance of a gel and having the rheological profile according to the invention. According to one preferred embodiment of the invention, the hydrophilic gelling material is a hydrophilic gelling polymer. . .Such polymers can be, more particularly, water-soluble or water-dispersible terephthalic copolyester oligomers essentially comprising dicarboxylate repeating units of formula (I). . .(I')". Thus, since O'Neill teaches the same compounds of formula (I), as those of the instant invention, the rheological properties must be the same, though they are not explicitly stated by O'Neill.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for

Application/Control Number: 09/380,888  
Art Unit: 1617

Page 9

the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
July 31, 2003



SREENI PADMANABHAN  
PRIMARY EXAMINER

8/9/03